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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/972,313	11/18/97	PICKENS	

MM21/0526

ROBERTS & BROWNELL
8381 OLD COURTHOUSE ROAD
SUITE 212
VIENNA VA 22182

EXAMINER
TREMBLAY, M

ART UNIT
2676

DATE MAILED: 05/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	08/972,313	PICKENS, THOMAS BOONE	
Examiner	Art Unit	Mark Tremblay	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1) Responsive to communication(s) filed on 07 April 1999.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9 and 13-27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-9 and 13-27 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:

1. received.

2. received in Application No. (Series Code / Serial Number) _____.

3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) Notice of References Cited (PTO-892) 17) Interview Summary (PTO-413) Paper No(s). 6.

15) Notice of Draftsperson's Patent Drawing Review (PTO-948) 18) Notice of Informal Patent Application (PTO-152)

16) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 19) Other:

Applicant: Thomas Boone Pickens III

Filing date: 11/18/97

Part III Action on the Merits

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7, 9, and 13-15 drawn to an optical scanning system, and claims 16-18, 20, and 23-27 drawn to an optical scanning method are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,804,803 to Cragun et al. ("Cragun" hereinafter). Cragun discloses an optical scanning system for scanning graphical codes 117 which are displayed on an object 115 to obtain the encoded Internet address for the object comprising:

an object 115 comprising:

text displayed on the object (see e.g. column 11, lines 28-51); and

at least one graphical code 117 displayed on the object, the graphical code further comprising an encoded Internet address (URL-- see e.g. column 4, lines 35-40);

scanning means 118 for optically scanning the graphical code; and

a computer 102 connected to the scanning means and further comprising processing means 104 for decoding the scanned encoded Internet address.

Cragun does not disclose a two dimensional codes. Two dimensional codes are old and well known. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a two dimensional code instead of a one dimensional code because two dimensional codes can store more information, as was widely recognized in the art at the time the invention was made. Thus, for a long Internet address, the two dimensional code can store all the information in a small space (e.g. on a small consumer item).

With respect to the size of the bar code being the same size as the text, this is merely a matter of changing the size of a known object which has no absolute size restrictions. The Minicode cited by Applicant is a case in point. The Examiner has cited further background information about the known code relied upon by Applicant. The Examiner notes that Applicant does not invent a new type of two dimensional code, but rather relies on the teachings of others. Minicode is typically on the order of 1 inch square. One proposed minimum is .6 inches by .6 inches (15.24 mm x 15.24 mm). The references incorporated by Applicant to support the "two dimensional" claim language do not cite a minimum size. It is clear that it is the Applicant's position Minicode can be any size the artisan wants, and no teaching is required concerning how to make the symbol smaller. Making the code smaller is easier than obvious. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the two dimensional code the same size as the text in order to fit the code within text that commonly appears on objects, so that preceding or succeeding lines of text wouldn't have to be spaced far apart. Note that since no text size is specified, the code might not be that small to meet the claims. The Examiner has cited pertinent art to elucidate this point. In many cases, the text on objects has many different sizes. The Examiner has broadly interpreted the claim to mean that the code is at least smaller than the largest text on the document.

Cragun discloses an optical scanning system as described above, but does not disclose a wireless infrared scanner. Official Notice is taken that wireless infrared scanners are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use an infrared scanner as a substitute for the 2.4 GH scanner mentioned by Cragun because an infrared scanner performs substantially the same function (transceives data) in substantially the same way

(without wires) to obtain substantially the same result (a person can walk around with the terminal, but still send and receive data to another computer).

Re claim 12-13, 23-24 note that the bar code on the top of the Cragun patent is approximately 7mm high. Smaller bar code heights are old and well known.

Claims 8, drawn to an optical scanning system, and claims 19, 21-22 drawn to an optical scanning method are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,804,803 to Cragun et al. ("Cragun" hereinafter) in view of U.S. Patent #5,640,193 to Wellner ("Wellner" hereinafter). Cragun teaches the invention as described above, and further states that many different computer hardware and software configurations can be used to accomplish the objectives of the disclosure. See column 5, lines 1-52. Wellner teaches that bar codes can be used in a manner similar the URL in NCSA Mosaic, an Internet browser (see column 4, line 37). All that is required for a person of ordinary skill in the art is to buy a bar code "wedge" scanner (this type of scanner behaves exactly like a keyboard as far as the personal computer is concerned), and use it to scan in a URL written in Code 39 (for example-- code 39 fonts are available in WordPerfect and other popular word processing programs) when the cursor is positioned in the "Location" window of a browser. Cragun states that the disclosure applies to personal computers such as the Macintosh (column 5, line 37-38), and Wellner describes a similar system and its likeness to a Web browser. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a Web browser as described by Wellner to receive the URL described by Cragun, because the Web browser was recognized as the easiest method for accessing data on the Internet using a personal computer such as an Apple Macintosh.

Response to Arguments

The Applicant is urged to consider the Cragun patent, and the bar code printed on the front. Currently, on the Examiner's desktop, there is a bar code reader that will read this code and present it into any application as though it were a number entered on the keyboard. The Examiner also has a Netscape Navigator (TM) application where a patent number is entered in

order to get more information about that patent. Unfortunately, the format of the bar code is useless for this application, since the designers of the Web application did not consider the format of the bar code, or vice versa. On the other hand, the patent application file wrapper (which can be construed as an "object") used to store the Applicant's invention does have a bar code where information can be directly entered into a browser to retrieve further information about the application. In fact, there are two bar codes for the same numbers printed in two different heights and lengths. The bar codes are roughly the same height as the larger text. The Examiner had the Netscape application site available in the spring of 1997, but no bar code reader was provided until the about the fall of 1998. However, bar code readers which mimic the function of a keyboard were notoriously old and well known in the Spring of 1997.

The general problem with the current invention versus the prior art is that by 1997, bar code readers functioned like keyboard substitutes, bar codes were substitute fonts (the Examiner has had bar code fonts for WordPerfect (TM) since at least 1996), and any web browser could be activated by substituting a bar code reader and bar code for any written alphanumeric text that might be entered into the browser location window manually by keyboard. The entire reason for the existence of bar codes is to substitute a bar code and bar code reader for alphanumeric information and a keyboard (typically, at a cash register). However, the Examiner chooses to rely on Cragun for written evidence that is fixed and dated.

The Applicant asserts that the Cragun invention is differentiated by its use: typically in a store. However, Examiner points out that Cragun teaches that the invention is not limited to a store: it is applicable to the many examples listed in column 11, lines 28-52. Note that Cragun listed those as *examples*. Moreover, since the Applicant states that Applicant's own invention can be used in a store, the asserted difference is even less persuasive.

The Applicant also asserts that the Cragun teachings are not applicable because Cragun teaches an embodiment where customer cards are used to check out computers, and enter customer information. The examiner respectfully disagrees. Again the cited difference is a non-limiting example. Cragun teaches the use of personal computers, among other things, as an alternative to the example cited by the Applicant.

The Applicant argues that the Cragun claims contrast with the instant invention. Examiner accepts this characterization, but notes that the disclosure limits the scope of the claims, not the other way around. The claim limitations with respect to the customer information do not limit the teachings as a whole.

With respect to the height, the Examiner has made further arguments in the statement of the rejection. The Examiner would like to address the statement that "the present invention is able to encode the information by expanding the graphical code in the non height direction." If the Applicant is relying on U.S. Patents 5,153,418 and 5,223,701 to support this statement, the Examiner notes that these are essentially square codes by definition. Examiner presumes that the codes will be tiled, or printed next to each other. This is the same as printing additional letters next to each other to increase the length of words or sentences. It is not new.

With respect to Applicant's arguments about Cragun's teachings of abbreviated URLs, Examiner notes that in most machine readable systems, the goal is to get the most information in the smallest space possible. Teaching a method of abbreviating URLs does not negate the need to print whatever the URL is, abbreviated or not, into a small space, for example to fit on a business card (an example of an object given by both the Applicant and by Cragun).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Internet

PTO maintains an extensive web site at <http://www.uspto.gov>. Communications about this application via e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be addressed to **mark.tremblay@uspto.gov**. All Internet e-mail communications will be recorded in the application. PTO employees don't use the Internet to exchange sensitive information unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. For more details, see the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Voice

General inquiries or status inquiries about this application should be directed to the Group 2800 Receptionist at (703) 308-0956. Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 8:30 am to 6:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Don Hajec, can be reached on (703) 308-4075. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

Fax Procedures

Application papers may faxed to Art Unit 2876 at (703) 308-7724. Faxes must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers solely for the examiner's consideration, and not intended for immediate entry into the application (e.g., a proposed amendment) should be unsigned and clearly marked "Draft Copy" and/or "Deliver Directly to Examiner."

MT
5/18/99


Donald T. Hajec
Supervisory Patent Examiner
Technology Center 2800